

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Our Docket No.: 406590)

In re the Application of

Paulsen, Craig

Serial No.: 10/008,748

Filed: December 6, 2001

For: PROGRAMMABLE COMPUTER
CONTROLLED EXTERNAL
VISUAL INDICATOR FOR
GAMING MACHINETo: Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Art Unit: 3713

Examiner: Enatsky, A.



27717

PATENT TRADEMARK OFFICE

RESPONSE VIA FACSIMILE

Dear Sir:

In response to the Office Action mailed May 29, 2003, and pursuant to the Request for Continued Examination filed simultaneously herewith, Applicant provides the present Response.

Claims 1-24, 31-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,605,506 to Hoorn et al. (Hoorn) in view of U.S. Patent No. 6,265,984 to Molinaroli (Mol). Applicant respectfully transposes this rejection because it would not have been obvious to one of ordinary skill in the art in view of Mol and Hoorn to arrive at Applicant's claimed invention. In summary, because Mol discloses a moveable LED device it would not be obvious to arrive at the claimed stationary device, both Mol and Hoorn teach away from the combination proposed by the PTO and there is no suggestion to combine. Therefore, the rejection is improper.

Applicant notes that claims 25-30 are pending in this application but are not rejected in the Detailed Action. Applicant requests that claims 25-30 be indicated as allowed or a rejection be provided in the Detailed Action therefor.

Claim 1 of Applicant's invention requires an external visual indicator mounted to the gaming machine. Because the visual indicator is mounted to the gaming machine, it is clear that the visual indicator is stationary. The external visual indicator includes multiple LEDs providing a color display including illumination of multiple colors. The claimed invention also includes a programmed processor providing for the control of the color display of the external visual indicator. Hoorn fails to teach or suggest all of these elements. Hoorn fails to disclose a visual indicator including multiple LEDs. Hoorn also fails to disclose a processor of the gaming machine providing for control of the color display of the external visual indicator.

Hoorn discloses a light source 186. However, as admitted by the PTO, there is no disclosure in Hoorn of an LED. Further, Hoorn only discloses a host computer 8 that is remote from the gaming machine. There is no disclosure in Hoorn of a processor that is part of the gaming machine providing for control of the color display of the external visual indicator. Therefore, all of the elements of the claimed invention are not disclosed in Hoorn (see attached Rule 132 Declaration of Craig A. Paulsen, (hereinafter "Paulsen Declaration") paragraph 1).

Mol discloses a display device, but not a display device for a gaming machine. Mol discloses embodiments, each which must be in motion to operate. Mol discloses a traffic light baton that is waved back and forth. A circular ceiling mounted display has LEDs that rotate. A hand-held display device is moved back and forth. A keychain display device is moved back and forth. A pen display device is moved. A wristwatch display device operates when you swing your arm. A display device of a bicycle operates when the wheel rotates. A vehicle window

display device operates when the car moves. A fan display device rotates. A Christmas tree-shaped display device rotates. A plug-in globe-shaped display device has LEDs that rotate. A net fabric style baseball-style cap has a rotating display device. A shoe display device operates with motion. A hand-held display device is mounted to a moving mechanical arm. A yo-yo display device operates when yo-yoing. A projection display device having three axes has translucent lens strips that are spun in front of the lights.

As each of the embodiments of Mol are not for a gaming machine and each embodiment is not stationary for the operation of the LEDs, Mol fails to teach or suggest the use of a display device for a gaming machine. Further, Mol fails to teach or suggest a display device for use as a candle of a gaming machine (see Paulsen Declaration, paragraph 4). As well, Mol fails to teach or suggest a stationary light display device. Thus, MOL fails to teach or suggest all of the elements of the claimed invention (see Paulsen Declaration, paragraph 2).

Furthermore, the stationary external visual indicator mounted to a gaming machine of the present invention is not obvious over Hoom in view of Mol and one of ordinary skill in the art, in view of Mol with Hoom would not have arrived at an invention of a gaming machine having a programmed processor providing for the control of the color display of the external visual indicator including multiple LEDs. These limitations are present in independent claims 1, 18 and 40.

There is no suggestion to combine the teachings of Mol with Hoom, or vice versa. The PTO states that the LED display of Mol "could be mounted" (emphasis added) on any surface. In view of what "could" be done with Mol, the PTO concludes that it would have been obvious to one of ordinary skill in the art to modify Hoom to replace the illumination display for the "inexpensive" LED light display of Mol. However, it is improper to combine Hoom with Mol

based on what "could" or "can" be accomplished; absent a suggestion to combine. *In re Mills*, 915 F.2d 580 (Fed. Cir. 1990). The fact that references could or can be combined is not sufficient to establish a *prima facie* case of obviousness -- the prior art must also suggest the desirability of combination. MPEP § 2143.01. The references must expressly or impliedly suggest the claimed invention, or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious. *Ex Parte Clapp* 227 USPQ 972, 973 (Bd. Pat. App. Inter. 1985). The PTO has failed to indicate specifically where such a suggestion exists in Hoom or Mol for combination. Also it is respectfully submitted that the PTO has failed to provide a convincing line of reasoning why it would be obvious to combine Hoom and Mol.

It would not have been obvious to combine Hoom and Mol (see Paulsen Declaration , paragraphs 3-8). Merely because the Hoom reference discloses the use of incandescent lighting (that the PTO suggests may be expensive). It still fails to provide a suggestion that other types of lighting devices should be substituted for the disclosed incandescent lighting. As well, there is no disclosure in Hoom concerning the expense of incandescent lighting. Further, there is no disclosure in Hoom that incandescent lighting is not versatile. To the contrary, Hoom teaches that light bulbs are versatile because they are easily replaceable (col. 6, lines 50-51 and see Paulsen Declaration paragraph 9). The PTO's recitation of reasons why substituting the LEDs of Mol for the incandescent lighting of Hoom is hindsight reconstruction of the prior art -- attempting to insert suggestions that are not present in Hoom. The PTO's lack of citation in Hoom as to where the suggestion to combine is disclosed, underscores the PTO's failure to establish a *prima facie* case of obviousness.

In fact, Hoom teaches away from combination with Mol. Hoom teaches that it may be desirable to easily replace components such as light bulbs and antennas (col. 6, lines 50-51). LEDs were not generally easily replaceable and Mol doesn't teach such easy replaceability (see Paulsen Declaration paragraph 10). Thus, one of skill in the art in view of the teaching of Hoom would only consider easily replaceable items; unlike the LEDs of Mol. Mol also teaches away from combining with Hoom. The device of Mol requires movement, such as rotation of the LEDs (see Paulsen Declaration paragraphs 6 and 7). Hoom concerns only a stationary device such as a candle mounted to a gaming machine. MOL has no disclosure concerning gaming machines. Thus, one of ordinary skill in the art would not be motivated to combine the movable LEDs of Mol with the stationary device of Hoom or considered MOL with regard to Hoom (see Paulsen Declaration, paragraph 5). Therefore, it would have been obvious to one of ordinary skill in the art in view of MOL and Hoom to arrive at the presently claimed invention.

As well, substitution of an LED of Mol in the candle of Hoom will change the principle operation of Hoom. If one of skill in the art attempted to combine the light displays of Mol into the candle of Hoom, some modification is necessary. One of ordinary skill in the art could not just substitute the movable LED arrangements of Mol with the stationary light bulb of Hoom without modification (see Paulsen Declaration paragraph 11). Such substitution without modification would change the principle operation of Hoom. Thus these references are not sufficient to render the claims *prima facie* obvious. *In re Patti*, 270 F.2d 810 (CCPA 1959). If you attempt to modify the moveable light displays of Mol, there is no teaching provided for such modification and one of ordinary skill in the art could not make the modification. For example, there is no teaching of how to modify the ceiling mounted display (Fig. 4 of Mol) so that the candle of Hoom may include therein an antenna, a rod for a ground plane and a rod to hide a

coaxial cable, as required by Hoom. There is no teaching of where to put an antenna when the movable LED displays of Mol are rotating inside the housing. There is also no teaching in Mol of how the rotatable and moveable LEDs should be modified in order to operate in the stationary device of Hoom that is mounted to a gaming machine, as claimed by claims 1, 18 and 40. There also is no teaching of how the LEDs of Mol would be arranged to be responsive to an input operation by a user of a gaming machine or a first special event of a gaming machine, as claimed by claims 1 and 18, respectively.

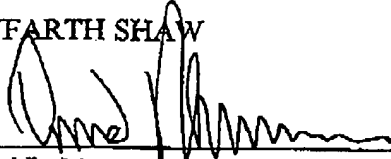
Therefore, there is no suggestion to combine MOL with Hoom and one of ordinary skill in the art would not have been motivated to combine MOL with Hoom and would not have arrived at an invention of a gaming machine having a programmed processor providing for the control of the color display of the external visual indicator including multiple LEDs (see Paulsen Declaration paragraph 12).

Therefore, independent claims 1, 18 and 40 are allowable. All of the other dependent claims which depend from claims 1, 18 and 40 include all the limitations of the independent claims and are also not taught or suggested by Hoom in view of Mol. Therefore, the rejection under §103(a) is improper and applicant respectfully requests that all claims be allowed.

If the examiner has further questions or would like to discuss the application, please
contact counsel for Applicant at the information listed below.

Respectfully submitted,

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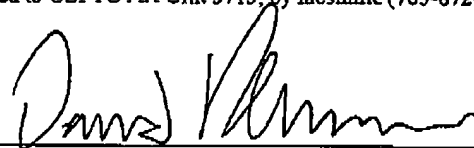
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Registered Attorney for Applicant

Date: 7/16/03